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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,084	03/31/2004	Stephen T. Flock	D6462CIP2	7354

7590 03/27/2008  
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EXAMINER
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ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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03/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/815,084	<b>Applicant(s)</b> FLOCK ET AL.	
	<b>Examiner</b> AARON ROANE	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/28/2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 13 and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (USPN 4,889,120).

Regarding claims 1-5, Gordon discloses a method of treatment for one or more tissue substrates in an individual, comprising: securing the tissue substrate(s) proximal to a ferromagnetic metal susceptor; applying radiofrequency energy that generates a magnetic field to said substrate(s) or to said susceptor or to a combination thereof to inductively generate heat therein; and fixing said substrate(s) via said heat thereby effecting treatment, see abstract, col. 2, line 28 through col. 3, line 62.

Regarding claims 6 and 7, Gordon discloses the claimed invention, see col. 6, lines 43-48.

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Regarding claims 8 and 9, Gordon discloses the claimed invention, see col. 3, lines 8-25 and col. 6, lines 43-48.

Regarding claims 13, 15-18, Gordon disclose the claimed invention, see col. 5, lines 48-65.

Regarding claims 19 and 20, Gordon discloses the claimed invention, see col. 2, lines 1-18 and lines 44-53.

Claims 1-5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Paulus et al. (USPN 5,429,583).

Regarding claims 1-5, Paulus et al. disclose a method of treatment for one or more tissue substrates in an individual, comprising: securing the tissue substrate(s) proximal to a ferromagnetic metal susceptor ("ferromagnetic seeds"); applying radiofrequency energy that generates a magnetic field to said substrate(s) or to said susceptor or to a combination thereof to inductively generate heat therein (see claim 8); and fixing said substrate(s) via said heat thereby effecting treatment, see abstract, col. 3, lines 21-57 and col. 4, line 29 through col. 6, line 59.

Regarding claim 11, Paulus et al. disclose the claimed invention, see col. 8, lines 18-45.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paulus et al. (USPN 5,429,583) as applied to claim 1 above, and further in view of Dann (USPN 6,248,236).

Regarding claims 21 and 22, Paulus et al. disclose the claimed invention except for monitoring the heat of the susceptor via optical infrared detection. Dann discloses an apparatus and method for treating the prostate with seeds and teaches providing a temperature sensor in order to monitor the temperature of the seed and surrounding tissue to provide precise feedback control such that non-diseased tissue is not damaged, see col. 3, lines 24-65. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Paulus et al., as taught by Dann, to provide the method with a temperature feedback control in order to monitor the temperature of the seed and surrounding tissue to provide precise feedback control such that non-diseased tissue is not damaged.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paulus et al. (USPN 5,429,583) in view of Dann (USPN 6,248,236) as applied to claim 23 above, and further in view of Edwards (USPN 6,814,712).

Regarding claims 23 and 24, Paulus et al. in view of Dann disclose the claimed invention except for heat detection via an optical detector using infrared. It is extremely well known that optical temperature sensors sense black body radiation in the infrared range. Edwards et al. disclose an prostate heating apparatus and teach "one or more temperature sensors 46, which can be conventional thermistors, thermocouples or optical fibers, are positioned along the catheter to provide a temperature profile of the urethra adjacent to and preferably on both sides the stylet section," see col. 9, lines 9-27 and figures 2 and 3. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Paulus et al. in view of Dann, as taught by Edwards et al., to use one or more optical temperature sensors in order to sense the temperature.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9, 11 and 13-24 have been considered but are moot in view of the new ground(s) of rejection.

Although there are new grounds of rejection, the examiner wishes to make a point that may expedite prosecution. It should be noted that the rejections based on Paulus et al.

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(individually and in combination with other prior art) use a very broad interpretation of the term “fixing” in the claims. The examiner’s interpretation of “fixing” includes improving, making better and the like. Although this interpretation is very broad, there is nothing in the present specification that precludes the examiner from using such a broad interpretation.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON ROANE whose telephone number is (571)272-4771.

The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Roane/  
Examiner, Art Unit 3739

/Henry M. Johnson, III/  
Primary Examiner, Art Unit 3739